

Remarks

Obviousness

The sole issue is whether the applicants' claims 1, 3-6, 11-12 and 15-27 are rendered obvious by Mathies et al. in view of Macken and thus are not allowable under 35 USC 103. An analysis of the cited references indicates that reconsideration is warranted.

No proper teaching to combine is cited.

The obviousness rejections should be reconsidered because there is no proper teaching for the combination of the cited references. "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight based obviousness analysis is a rigorous application of the requirement for a showing of the teaching or motivation to combine the prior art references." *In re Dembicza*k, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (internal citations omitted). "The showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In applying this law to the present claims, a finding of obvious should be reconsidered.

A. No clear and particular teaching to combine exists.

The law requires a clear and particular teaching to be found in the cited references. Such a teaching must come

from the references. In addition, broad conclusory statements are deemed not sufficient. However such broad conclusory statements are all that are proffered in the present Office action to motivate the cited combination.

The sole reason given in the Office action for combining the two cited references, set out on page three of the Office action, is that the two cited references are in the same "area" of laser scanning. This simply is not the required clear and particular teaching to make the suggested combination. Nothing is cited in either reference that would motivate making the substantial modification in optical systems suggested in the Office action. Given that no such a showing is made, the combination should be reconsidered.

B. Mathies et al. specifically teaches away from combination with Macken.

Not only is there no teaching to combine the cited references, the two references actually teach away from their combination.

As the Office action notes, both the references are laser scanning systems. However this scanning is effected in very different ways. In Mathies et al., each of the illustrated embodiments already has a scanning means. For example, in figure 1, the scanning is effected by moving particles in a stream of liquid past a stationary illumination source. (See Mathies et al. col. 3, lines 15-20). In figure 9 and 11, the scanning is effected by moving the sample (See Mathies et al. col. 6, lines 33-37; col. 7, lines 16-20). In figure 10, a galvo scanner is used to scan the sample. (See Mathies et al. col. 6, lines 59-65).

Macken teaches a mirror configuration for scanning. However given that each of the Mathies et al. already include a scanning means as noted, there would be no possible reason to modify Mathies et al. to adapt a scanning mirror device, as

suggested in the Office action. This again presents an independent reason to withdraw the present rejection.

C. The proposed combination renders Mathies et al. unfit for its intended purpose.

Finally, the law states that a combination is not permissible if the combination of elements from one source would render the technology from the other cited source unfit for its intended purpose.

The Office action seems to suggest that the lens 72 of fig. 9 of Mathies et al. could be modified adapt the reflector Macken shown in Fig. 2. However if such a substitution is made, lens 72 will cease to serve its function, namely focusing light through a pinhole and onto a detector as shown in Mathies et al. Fig. 9. Without such focusing, the scanner taught by Mathies et al. would simply not work.

No clear and particular teaching has been cited from either of the identified references that would lead to the suggested combination. Instead, the Mathies et al. reference teaches away from combination with Macken. In addition, it appears that making the cited combination would render Mathies et al. unfit to act as a scanner. Given this combination of facts, the present rejection should be withdrawn because no proper teaching to combine the reference has been cited.

The asserted references do not render obvious the applicant's claims.

Even if the references are combined, this combination does not render obvious the applicant's claims. An obviousness determination requires determining the scope and content of the prior art and ascertaining the differences between the cited art and the claims at issue. See *Graham v. John Deere Co.*, 148 USPQ 459 (S.C. 1966). When applying 35 USC Section 103 in a finding of obviousness, the tenants of

patent law require that the claimed invention be considered as a whole, that the cited references must suggest the desirability and thus the obviousness of making the claimed combination, that the cited references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention, and that the cited reference provide a reasonable expectation of success in practicing the claimed technology. See *Hodosh v. Block Drug Co., Inc.*, 229 USPQ 182, 187 (Fed. Cir. 1986).

In the present instance, the Office action on page 2 notes that Mathies et al. teach "a reflective light collector (lens 72 of fig 9) positioned proximate to said sample container (sample substrate 50 of fig 9)". First, lens 72 is not reflective. If this lens were reflecting light, the light would be reflected back to element 71 by lens 72. Instead, the light is shown as being focused by lens 72 through pinhole aperture 73 and onto detector 76. A lens is a refractive, not a reflective, optical element. Second, this lens does not appear to be a light collector. Light is collected from the sample in this embodiment of Mathies et al. by element 71, not lens 72. Third, the lens 72 is not "proximate to the sample" as required by claim 1. Instead, the lens is shown removed from the sample, with element 71 interposed between lens 72 and the sample. Given that the cited references fail to teach both a claimed element and a claimed positioning of that element, this reference does not in combination with Macken render obvious claim 1 or the claims dependent on claim 1.

Independent method claim 20 was rejected on page 7 of the Office action. The Office action states that Mathies et al. show "collecting fluorescent emission with a reflective light collector, (collector 72 of fig 9) said light collector having a focal depth, said light collector collimating said collected light into a collimated emission beam (laser beam from light source 68 of fig 9)". Again, a number of the

actual claimed steps are not in fact taught as suggested in the Office action.

First, fig. 9 of the cited reference does not teach collecting light with a reflective light collector. Element 72 is not a reflective light collector, as indicated in the Office action, but instead is a lens. As noted above, if this lens were a reflector, light would not reach the detector in the disclosed embodiment.

Second, the applicants' claim 20 requires that "said light collector collimating said collected light". However element indicated in the Office action to be a "light collector", lens 72, plainly does not collimate light, but instead focuses light through a pinhole as shown in Fig. 9. The Office action notes that the light from the light source in fig. 9 of Mathies et al. appears to be collimated. Even if this is true, the cited reference still fails to disclose the claimed method, namely the collimating of light by a light collector. As with claim 1, the claimed elements are simply not found in the cited reference. Given this fact, the rejection of claim 20 and the claims dependent on claim 20 should be reconsidered and withdrawn.

The only way in which the Office action was able to assert that the two cited references render obvious the applicant's claims is to use the applicant's claims as a template, with unrelated and mischaracterized elements in each reference used to compile the elements of the applicants claims. This hindsight based obviousness rejection is proscribed by the law.

Conclusion

The applicants respectfully request reconsideration in light of the submitted remarks and amendments. A notice of allowance is earnestly solicited. If any matter relating to this case needs to be discussed please call our office at (408) 297-9733 between 9 a.m. and 5 p.m. Pacific time.

Respectfully submitted,

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, Alexandria, VA 22313-1450.

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